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DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY.,
SUITE 2110
AUSTIN, TX 78759

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NEWAY, SAMUEL G	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SIMON CHU, RICHARD ALAN DAYAN, JEFFERY BART JENNINGS, and DAVID B. RHOADES

Appeal 2009-003185
Application 10/675,614
Technology Center 2600

Decided: April 29, 2010

Before JOHN C. MARTIN, JOSEPH F. RUGGIERO, and MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-5, 7-13, 15-21, 23, and 25. Claims 6, 14, 22, and 24 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed December 28, 2007) and the Answer (mailed February 15, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

Appellants' Invention

Appellants' invention relates to the managing of software according to the physical location of a computer that is to execute the software. When the computer's operating system, which has been modified to include a location service, requests that an application be loaded into system memory, the location service determines the exact physical location of the computer using a satellite Global Positioning System (GPS). If the computer is within an authorized location range, the application is allowed to load into system memory and execute as long as the computer remains within the authorized area. (Spec. ¶ [0005]).

Claim 1 is illustrative of the invention and reads as follows:

1. A method for regulating execution of a software according to a physical location of a computer on which the software is to be executed, the method comprising:

storing a first list of authorized location ranges where a computer is authorized to execute a first software;

determining a physical location of the computer;

comparing the physical location of the computer with the first list of authorized location ranges;

executing the first software only if the physical location of the computer is within a range of one of the authorized location ranges from the first list of authorized location ranges; and

executing the first software only if the computer does not receive information derived from a GPS signal.

The Examiner's Rejection

Claims 1-5, 7-13, 15-21, 23, and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

ISSUES

The pivotal issues before us are whether the Examiner erred in determining:

a) the language of appealed independent claims 1, 9, and 17 requires that both of the recited software execution conditions must occur before software execution is permitted, and

b) if so, Appellants' disclosure does not describe the software execution procedure in which both recited execution conditions are required in accordance with the written description requirement of the first paragraph of 35 U.S.C. § 112.

FINDINGS OF FACT

The record supports the following relevant findings of fact (FF) by a preponderance of the evidence:

1. Appellants' disclosure (Figs. 2-3, Spec. ¶ [0005]) relates to the regulation of the execution of software according to a physical location of a computer on which the software is to be executed.

2. Appellants' disclosure (Figs. 1-2, Spec. ¶ [0017]) also describes a location service 208 within computer 100 which receives real time coordinates from a GPS receiver within computer 100, and compares the real time locations with a list 222 of approved locations. If the real time coordinates are found in the approved list, software execution is permitted.

3. At paragraph [0025], Appellants' Specification discloses "[a]lternatively, location service 208 may be structured such that the presence or lack of a GPS signal either enables or prohibits the loading of an application."

PRINCIPLES OF LAW

The function of the written description requirement of the first paragraph of 35 U.S.C. § 112 is to ensure that the inventor has possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976), *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). In establishing a basis for a rejection under the written description requirement of the statute, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an

applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 265.

ANALYSIS

Each of the appealed independent claims 1, 9, and 17 is directed to the regulation of the execution of software and includes a recitation of two conditions in which software is permitted to execute. These two conditions are i) software execution only if the physical location of the computer is within an authorized location range *and* ii) software execution only if no information derived from a GPS signal is received.

The Examiner has taken the position (Ans. 4-5) that, while both software execution conditions are disclosed, Appellants' disclosure lacks a written description of any procedure or requirement that both conditions occur before software is permitted to execute. In response, Appellants contend (App. Br. 4-5) that there is no support for the Examiner's presumption that the claimed two software executing conditions are mutually exclusive so that only one or the other may occur.

We agree with the Examiner. The only written description of the claimed second software execution condition, i.e., execution only if a GPS signal is not received, appears at paragraph [0025] of Appellants' Specification. (FF 3). This description, however, is unambiguously disclosed to be an *alternative* procedure to the previously described software executing condition which compares a determined physical location of a computer with an authorized physical location range.

The language of the appealed independent claims, however, ties the two recited software execution conditions together by using the inclusive

"and" language, thereby requiring both conditions to occur in order to enable software execution. Further, Appellants' argument (App. Br. 5) that the two software executing conditions are not intended to be mutually exclusive at least impliedly suggests that the two conditions must occur together, a procedural feature which has not been described in Appellants' disclosure.

In view of the above discussion, it is our opinion that, under the factual situation presented in the present case, the statutory written description requirement has not been satisfied because Appellants were clearly not in possession of the claimed invention at the time of filing of the application. Therefore, we sustain the Examiner's rejection of appealed claims 1-5, 7-13, 15-21, 23, and 25 under the first paragraph of 35 U.S.C. § 112.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that, since Appellants' disclosure does not comply with the written description requirement of the statute, the Examiner did not err in rejecting appealed claims 1-5, 7-13, 15-21, 23, and 25 under 35 U.S.C. § 112, first paragraph.

DECISION

The Examiner's 35 U.S.C. § 112, first paragraph, rejection of appealed claims 1-5, 7-13, 15-21, 23, and 25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tkl

DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY.,
SUITE 2110
AUSTIN, TX 78759